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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 Ex parte WALTER HENRY BERRYMAN
11

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13 Appeal 2009-002060
14 Application 10/694,888
15 Technology Center 1700
16

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18 Oral Hearing Held: May 13, 2009
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22 Before PETER F. KRATZ, JEFFREY T. SMITH, and
23 LINDA M. GAUDETTE, Administrative Patent Judges.
24

25 ON BEHALF OF THE APPELLANT:
26

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1 The above-entitled matter came on for hearing on Wednesday,
2 May 13, 2009, commencing at 9:34 a.m., at the U.S. Patent and Trademark
3 Office, 600 Dulany Street, Alexandria, Virginia, before Paula Lowery,
4 Notary Public.

5 THE CLERK: Good morning. Calendar Number 16, Appeal Number
6 2009-2060, Mr. Thomsen.

7 JUDGE KRATZ: Good morning, Mr. Thomsen.

8 MR. THOMSEN: Good morning.

9 JUDGE KRATZ: As you know, you have about 20 minutes, so you
10 can start whenever you're ready.

11 MR. THOMSEN: Thank you.

12 As you know, we've got three groups of claims. They do not stand or
13 fall together. Claim 1, as you know, includes three steps in a process:
14 applying a glassine dielectrode upon at least one surface of the substrate, and
15 the composition of the fitness selected according to temperature coefficients,
16 and the underlying purpose is substantially preventing bending.

17 Number two, firing the glassy electric diode layer at an oxidizing
18 temperature.

19 Thirdly, forming at least one thick film circuit upon the dielectric
20 layer. Again, choosing the composition and thickness based upon the
21 temperature coefficient so as to also substantially prevent bending.

22 As you know, the examiner in his 103 rejection based on obviousness
23 points out three things. It's the second layer, not the first layer in
24 Zimmermann, that's fired under an oxidizing layer.

25 Secondly, it admits that Zimmermann fails to recite controlled
26 bending by controlling processing parameters of fitness and coefficient

1 expansion.

2 Thirdly, despite the fact that these parameters are not explicitly
3 disclosed, it says that the desired result has been achieved.

4 So our contention is that the Examiner has failed to establish a prima
5 facie case of obviousness. The Examiner has not considered the invention as
6 a whole -- the three posited steps that we have recited in our Claim 1, and
7 instead has looked at piece after piece of this separately. I guess also I would
8 say that the burden of proof is on the Examiner to establish a burden of
9 proof, and I don't think that has been achieved.

10 Therefore, I would say that the Examiner must establish a factual
11 basis to support any conclusion of obviousness. In at least two places, we
12 don't believe that he's done so.

13 The Examiner admits that Zimmermann does not disclose the claimed
14 invention, but indicates that he does choose parameters to achieve the
15 desired result. However, I don't believe there's any factual evidence to show
16 that the parameters chosen had anything to do with bending or not bending
17 of the substrate.

18 JUDGE SMITH: So the Examiner doesn't cite to any part of the
19 reference for this feature? He just makes the statement?

20 MR. THOMSEN: Yes.

21 Secondly, the Examiner refers to the highly magnified drawings in the
22 Zimmermann document, which is best understood by us, are just very
23 narrow slices of the Zimmermann invention.

24 They really are too small to determine whether bending takes place or
25 not.

26 We, a year ago, submitted some samples of the substrate of our

1 invention, samples that were about three inches long, and showed under
2 various conditions whether they bent or not.

3 If one were to look at a comparable section of our substrate, I think it
4 would be impossible to tell whether bending had occurred or not.

5 I guess thirdly I would say regarding inherency, obviousness is not
6 based on inherency because while it may be possible or probable that the
7 Zimmermann device and the parameters -- the result of the Zimmermann
8 device -- did not cause bending, there's no disclosure that anyone was even
9 concerned about bending.

10 If he were, there's no disclosure in the Zimmermann specifications or
11 claims anywhere in the Zimmermann application that it showed how
12 bending -- prevention of bending was achieved.

13 JUDGE SMITH: She apparently didn't make an inherency argument
14 directly though, did she?

15 I know you respond to inherency in your Brief, but I didn't see where
16 the Examiner relied on inherency.

17 MR. THOMSEN: Perhaps not. I don't believe it could be used to
18 establish a prima facie case.

19 JUDGE SMITH: Actually, I see the Examiner did rely upon
20 inherency for the element of claims number 3.

21 MR. THOMSEN: Yes, she did.

22 Regarding claim 3, as you know our claim 3, the glassy layer includes
23 lead, and the method includes the step of diffusing lead through the titanium
24 oxide on the surface of the substrate to form a relatively strong bond.

25 Regarding claim 3, he relies on a secondary reference. In here he
26 talks about diffusing lead, and the Examiner's position was it would

1 inherently take place, as you point out.

2 Then he makes the point that the Examiner if we want to should show
3 -- should take on the burden of supplying evidence that that is not the case.

4 Upon such showing, the Examiner will reconsider his opinion. We
5 believe it's the Examiner's responsibility to establish whether or not such
6 lead would actually be diffused in the titanium substrate.

7 Again, on Claim 3, I don't believe a prima facie case of obviousness
8 has been established.

9 So, in summary, as is required by O'Farrell, it's best understood by us,
10 the invention has not been considered as whole.

11 The Examiner at least in a couple of cases has not provided a factual
12 basis to support his conclusion that either the bending does or doesn't occur,
13 or the thickness has been shown to have anything to do with bending or not
14 bending.

15 Thirdly, regarding inherency, Zimmermann does not dispositively
16 disclose the -- Zimmermann or the secondary reference, Sheram -- would not
17 positively disclose the recited features.

18 So it is our opinion that the Examiner has failed to make a prima facie
19 case of obviousness, and we would recommend that the Board overturn the
20 Examiner's rejection.

21 JUDGE SMITH: Any questions?

22 JUDGE KRATZ: No questions.

23 JUDGE SMITH: Any questions?

24 JUDGE GAUDETTE: No.

25 JUDGE SMITH: No questions. Thank you.

26 Whereupon, the proceeding at 9:43 a.m. was concluded.